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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,993	03/31/2004	Danilo Lambino	J&J5118	1398

27777 7590 12/08/2006

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EXAMINER

BOYER, CHARLES I

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary

Application No.

10/814,993

Applicant(s)

LAMBINO ET AL

Examiner

Charles I. Boyer

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8, 11, 14-16 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) 21-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8, 11, 14-16, 19, and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to applicants' request for continued examination received October 3, 2006. Claims 1-3, 5-8, 11, 14-16, and 19-25 are currently pending with claims 21-25 withdrawn.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3, 14-16, 19, and 20 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Slavtcheff et al, US 6,270,783.

Slavtcheff et al teach skin treatment compositions impregnated on a substrate (see abstract). An example of such a composition is a nonwoven fabric containing a resin dispersed in water along with microencapsulated cholesteryl ester carbonate which is impregnated in the fabric (col. 8, example 1). With respect to the viscosity claimed, the examiner notes that a viscosity as high as 10,000 cps is highly viscous, and would not easily impregnate a fabric. Accordingly, the examiner maintains the viscosity limitation is satisfied. With respect to the amount of liquid impregnate, the examiner notes this limitation is satisfied if only 1 part impregnate to 20 parts fabric is

present, which will still result in a dry-to-the-touch composition. As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

In the alternative, note that preferred amounts of substrate to adhesive composition is from 5:1 to 1:5, such that the smallest preferred amount of adhesive is 20% (col. 7, lines 15-20). Accordingly, there is ample teaching to use amounts of liquid impregnate that will satisfy the range presently claimed, and so it would have been obvious to one of ordinary skill in the art to employ at least 20% by weight of impregnate in example 1 and so render obvious the claims at hand.

Applicants have traversed this rejection on the grounds that the only products for application to the skin described in Slavtchef are adhesive strips that are "dry-to-the-touch" and so the reference fails to teach or suggest any product for use on the skin that comprises a liquid impregnate. As discussed above, the examiner maintains the reference provides ample teaching to use amounts of impregnate that will at least render obvious the claims at hand.

2. The rejection of claims 1-3, 5, 8, 14-16, 19 and 20 under 35 U.S.C. 102(b) as being anticipated by Charle et al, GB 1,304,375 is withdrawn in view of applicants' arguments. Applicants' argument that the reference does not contain a liquid impregnate appears to be correct.

The rejection of claims 1-3, 5-8, 14-16, 19, and 20 under 35 U.S.C. 102(b) as being anticipated by Norbury et al, US 4,878,775 is withdrawn in view of applicants'

arguments. Though example 1 does contain a water-borne adhesive applied to a non-woven polyester fiber web, it appears this adhesive is applied in small amounts and the reference does not contain a teaching that larger amounts of adhesive can be used.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-8, 11, 14-16, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang et al, US 6,429,261.

Lang et al teach fabrics impregnated with personal care compositions (see abstract). An example of such a composition is a wet wipe wherein a wetting composition is applied to the wipe (col. 39, lines 36-50). Said wetting composition may contain microcapsules as a delivery vehicle for skin care benefit agents such as retinol, retinyl palmitate, tocopherol, silicones, and mineral oil (col. 29, lines 5-19). Lang et al do not specifically teach a wipe containing microcapsules, however as Lang et al clearly teach microcapsules as a preferred delivery method for skin care agents in their wet wipe compositions, it would have been obvious to one of ordinary skill in the art to incorporate microcapsules in a wipe according to the teachings of Lang et al. With respect to specific compositions and properties of the microcapsules, the examiner


notes that the microcapsules of the reference are commercially available and are believed to encompass these limitations.

Applicants have traversed this rejection on the grounds that their invention achieves an unexpectedly high increase in whitening to the skin and other beneficial properties as compared to products outside the claimed invention and have cited examples in the present specification in support of this assertion. Such purported unexpected results however, are not commensurate in scope with the claims at hand. First, with respect to example 1 in the present specification referred to by applicants, one specific impregnate and encapsulated liquid are used. In the present claims, any impregnate or encapsulated liquid may be used. Will any impregnate and any encapsulated liquid yield applicants' unexpected results? Furthermore, the unexpected results referred to by applicants are based on a composition containing microcapsules as compared to a composition that does not contain microcapsules. The microcapsules contain mineral oil, a well-known skin emollient, and so it hardly seems unexpected that a composition containing mineral oil should demonstrate enhanced skin benefits over the same composition, except that it is devoid of mineral oil. That aside, this analysis fails to compare the product of the invention with the product of the reference. Recall that the reference teaches a composition containing encapsulated skin benefit agents. A demonstration that encapsulated skin benefit agents are desirable may be sufficient to obviate a reference that does not contain such benefit agents, but it does nothing to obviate a reference that teaches the very thing applicants are claiming as beneficial. Accordingly, the rejection is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles I. Boyer whose telephone number is 571 272 1311. The examiner can normally be reached on M-Th 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on 571 272 1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Charles I Boyer
Primary Examiner
Art Unit 1751